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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,496	03/23/1999	PAUL C. KOCHER		8477

7590 09/10/2004

Edward J. Radlo  
Sonnenschein Nath & Rosenthal LLP  
685 Market Street  
6th Floor  
San Francisco, CA 94105

EXAMINER

SEAL, JAMES

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/274,496

**Applicant(s)**

KOCHER, PAUL C.

**Examiner**

James Seal

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 and 42 is/are allowed.
- 6) ☒ Claim(s) 32-35, 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This Action is in response to applicant's correspondence of 2 February 2004.
2. Amendments to the specification have been entered.
3. Replacement Abstract has been entered
4. Claims 32-35, and 37-42 are pending.
5. A copy of the Draftsperson's Patent Drawing Review (PTO-948) is enclosed.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims <sup>32-35, 37-40</sup> are rejected under 35 U.S.C. 101 because they contain no mention of a

storage medium on which for example copy right mask are contain or a computer or processor on which the method which is recited is disclosed. The examiner notes that to make statutory, the computations must be referred to a computer or processor not just electronically generated. The examiner suggest "a computer executing computer readable media with instructions to" generate a content override mask X...

***Allowable Subject Matter***

6. Claims 41-42 are allowed.
7. The following is an examiner's statement of reasons for allowance: Claims 41-42 are pending. Claim 41 is independent. The examiner was not able to find in the prior of record the limitation as stated in claim 41 "applying a one-way cryptographic function to an authenticator value determining whether the results of applying said one-way function is represented in the results... allowing said requested action to be performed". These limitations are not found or

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suggested in the prior art of record. Cooperman US 5613004 discloses using a global mask (Column 13, lines 19-23) to the data by convolving the data and the mask using a convolution (Column 8, 1-9). Cooperman does not teach an authentication. Simmons does teach authentication but does not teach an authentication scheme in which “the decision to prevent copying ... depends on the results of applying one-way function is applied to the authenticator is not detected in the marked data”. This authentication scheme is not found in the prior art of record. Further search of the literature revealed three other documents. Rhoads US 5822436 discloses a device marks the data and if warranted uses the embedded information to disable the kiosk’s copying function (see Abstract). The embedded data is global but is not applied with a convolution. While Rhoads invention is reversible, he does not teach an authentication scheme in which “the decision to prevent copying ... depends on the results of applying one-way function is applied to the authenticator is not detected in the marked data”. Steinberg US 5862218 teaches an authentication scheme and a method of recovering the original data using a password. Again Steinberg does not teach an authentication scheme in which “the decision to prevent copying ... depends on the results of applying one-way function is applied to the authenticator is not detected in the marked data”. The patent by Herzberg EP 0717337 A1 probably comes closest to the recited limitation. Here validating the selected data object using the validation information stored in the validation structure which is accessed and a cryptographic hash value is calculated. Thus the authenticator is hashed however Herzberg does not teach decision “to prevent copying depends on ... not detected in the marked data”. Thus none of the references teach the desired limitation alone or in combination.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Seal whose telephone number is 703 308 4562. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703 305 4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWS

Jws  
AU 2135  
07 September 2004

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100